

REMARKS

I. Preliminary Remarks

The foregoing amendment is in the revised amendment format as described in the US PTO Official Gazette Notice on February 25, 2003. Accordingly, the provisions of 37 C.F.R. § 1.21, requiring submission of clean and marked up versions of the replacement claims, are waived. However, for the Examiner's convenience, a copy of the pending claims after entry of the foregoing amendment is attached hereto as Appendix A.

On page 2 of the Office Action, the drawings were objected to for failing to comply with the margin requirements set out in 37 C.F.R. § 1.84(g) and for containing black shading, which is not permitted under 37 C.F.R. § 1.84(m). Submitted herewith are formal drawings that correct these defects in the drawings. However, the formal drawings do not add new matter to the application.

The applicants do not intend by these or any amendments to abandon subject matter of the claims as originally filed or later presented, and reserve the right to pursue such subject matter in continuing applications.

II. The Rejections under 35 U.S.C. § 112, First Paragraph, for Lack of Enablement, Should Be Withdrawn

On pages 4 and 5 of the Office Action, the Examiner rejected claims 29 and 30 under 35 U.S.C. § 112, first paragraph, for lack of enablement. In particular, the Examiner stated that while the specification is enabling for isolated host cells transformed or transfected with the vector according to claim 28 and a method of expressing a protein *in vitro*, the specification fails to provide enablement for an *in vivo* host cell or a method of expressing a protein *in vivo*. Further, the Examiner stated the only real world utility contemplated for the claimed method of expressing a protein *in vivo* is gene therapy, and gene therapy is not enabled for reasons set forth in the first Office action mailed April 10, 2002. These rejections have been rendered moot by the foregoing amendment. In particular, claims 29 and 30 are now directed to isolated host cells and method of expressing a protein *in vitro*.

In light of the foregoing amendment, the Applicants request that the rejection of claims 29 and 30 under 35 U.S.C. § 112, first paragraph be withdrawn.

III. The Rejections under 35 U.S.C. § 112, Second Paragraph, Should Be Withdrawn

On pages 5 and 6 of the Office Action, the Examiner rejected claims 22, 44, 45, 47-51, and 56 under 35 U.S.C. § 112, second paragraph, as assertedly containing indefinite terminology.

The Examiner alleged that the phrase "enhances expression of a nucleic acid sequence" in claims 22, 44, and 45 was indefinite because the specification teaches a polynucleotide sequence that enhances translation from a polynucleotide, but does not teach a nucleic acid sequence that enhances expression of a polynucleotide itself. Amended claim 22 now recites a nucleic acid sequence that "enhances said protein expression by increasing translation of the mRNA encoding said protein." Amended claim 44 recites "enhanced protein expression." These amendments render the basis for rejecting claims 22 and 44 moot.

The Examiner also asserted that the phrase "a sequence derived from a wild-type virus" in claim 45 was indefinite because the specification does not provide a clear statement of the process by which a starting material is derivatized. Amended claim 45 requires that the sequence be derived from a gene within a wild-type virus. The Examiner also alleged claim 45 was indefinite because it was unclear how the claim further limited the claim from which it depends. Amended claim 45 is an independent claim. These amendments render the basis for rejecting claim 45 moot.

The Examiner asserted that claims 47-51 lack proper antecedent basis for the term "the 5'-untranslated region." Amended claims 47-51 have been amended to depend from claim 44 which recites the term "the 5'-untranslated region." These amendments render the basis for rejecting claims 47-51 moot. The Examiner also asserted that claim 56 lacks proper antecedent basis for the term "said gene expression vector." Claim 56 has been amended to recite "said vector," which has the proper antecedent basis in claim 55. This amendment in turn, renders the basis for rejecting claim 56 moot.

In light of the foregoing amendment, the Applicants request that the rejection of claims 22, 44, 45, 47-51 and 56 under 35 U.S.C. § 112, second paragraph be withdrawn.

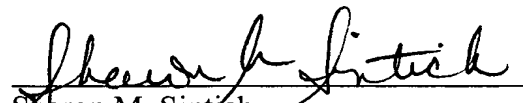
CONCLUSION

In view of the amendment and remarks made herein, claims 21-24, 26, 28-31, 33-39, 44, 45 and 47-65 are in condition for allowance and the Applicants request notification of the same.

Respectfully submitted,

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